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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/372,667	08/11/1999	MARK LEE AHRENS	10990502-1	1716

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EXAMINER

JONES, HUGH M

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 05/13/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

PR4

Office Action Summary

Application No.

09/372,667

Applicant(s)

Ahrens et al.

Examiner

Hugh Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 3, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-8, 10, 11, and 13-15 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10, 11, and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. Claims 1, 3-8, 10-11, 13-15 of U. S. Application 09/372,667, filed 08/11/1999 are presented for examination.

Claim Interpretation

2. The claims have been provided the broadest, most reasonable interpretation. Applicants appear to be claiming a closed circuit video system using a IEEE 488 bus system for testing of DUTs.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. **Claims 1, 3-8, 10-11, 13-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kamieniecki et al..**

5. Kamieniecki et al. disclose an automated signal generator apparatus which allows *testing of remotely-controlled electronic devices* to verify functionality and reliability, or for product set-up, initialization or configuration. The apparatus simulates a person pressing the keys on a remote control key pad, and can simulate key press sequences, key press duration, and time between key presses. Other human interfaces may also be simulated. The apparatus can be

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continuously driven by an external computer in a slaved mode, or can store test instructions in an internal memory to operate in a standalone mode. Test instructions, which may be written in a macro script language, are processed by a microprocessor to provide a control signal to, e.g., an infrared (IR) transmitter. The IR transmitter can control one or more electronic devices which are under test. The transmitter may use a wide angle IR beam, or a plurality of separate transmitters for testing of a plurality of electronic devices at the same time. In a human learning mode, control signals from a human interface are processed to provide time compression or repetition of a fixed control sequence.

6. In particular, Kamieniecki et al. disclose:

- connecting the DUT to a testing device (fig. 1; col. 2, lines 20-28; col. 3, lines 28-35; col. 4, lines 7-63; col. 5, line 47 to col. 6, line 62; col. 7, lines 16-40; col. 9, line 54 to col. 10, line 13);

- connecting a remote controlling device to the testing device (fig. 1; col. 2, lines 20-28; col. 3, lines 28-35; col. 4, lines 7-63; col. 5, line 47 to col. 6, line 62; col. 7, lines 16-40; col. 9, line 54 to col. 10, line 13);

- connecting a communications line (fig. 1 [# 125, 170]; col. 2, lines 20-28; col. 3, lines 28-35; col. 4, lines 7-63; col. 5, line 47 to col. 6, line 62; col. 7, lines 16-40; col. 9, line 54 to col. 10, line 13);

- using a video camera (col. 7, lines 27-40);

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- establishing a communications link between remote controller and remote controlling device (fig. 1; col. 2, lines 20-28; col. 3, lines 28-35; col. 4, lines 7-63; col. 5, line 47 to col. 6, line 62; col. 7, lines 16-40; col. 9, line 54 to col. 10, line 13);

- transmitting DUT data to remote controller (fig. 1 [# 180]; col. 2, lines 20-28; col. 3, lines 28-35; col. 4, lines 7-63; col. 5, line 47 to col. 6, line 62; col. 7, lines 16-40; col. 9, line 54 to col. 10, line 13);

- controlling testing device using input from remote controller (fig. 1; col. 2, lines 20-28; col. 3, lines 28-35; col. 4, lines 7-63; col. 5, line 47 to col. 6, line 62; col. 7, lines 16-40; col. 9, line 54 to col. 10, line 13);

- initializing, establishing and transmitting data/attribute of DUT (fig. 1; col. 2, lines 20-28; col. 3, lines 28-35; col. 4, lines 7-63; col. 5, line 47 to col. 6, line 62; col. 7, lines 16-40; col. 9, line 54 to col. 10, line 13);

- forwarding instructions to remote controller and forwarding to testing device (fig. 1 [# 180]; col. 2, lines 20-28; col. 3, lines 28-35; col. 4, lines 7-63; col. 5, line 47 to col. 6, line 62; col. 7, lines 16-40; col. 9, line 54 to col. 10, line 13);

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-8, 10-11, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chandler et al. in view of the taking of Official Notice.
9. Chandler et al. disclose an automatic circuit board tester for testing for shorts, opens, and interconnected pins or nodes on a circuit board. The tester first classifies the nodes as being in one of three categories based upon the design of the board and the intended interconnection of the nodes. The categories of nodes are: (1) connected to ground; (2) interconnected to all other nodes in the test group; or (3) isolated from all other nodes. The circuit board tester has a testhead containing a plurality of test channels, each configured to be coupled to a node on the circuit board. The testhead utilizes a digital signal from a digital driver to drive the node at a predetermined voltage and a digital receiver to read the node voltage to determine if it is coupled to ground. Each test channel also includes a switch to connect the digital driver and receiver to the test node as well as a ground switch to selectively couple the node to ground. Various combinations of switch positions and testing sequences enables the circuit board tester to test all node connections and to ensure that the physical embodiment of the circuit board accurately reflects the circuit board design.
10. In particular, Chandler et al. discloses:
 - connecting the DUT to a testing device (fig. 1-2; col. 3, line 21 to col. 4, line 24);

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- connecting a remote controlling device to the testing device (fig. 1-2; col. 3, line 21 to col. 4, line 24);

- connecting a communications line (fig. 1-2; col. 3, line 21 to col. 4, line 24);

- establishing a communications link between remote controller and remote controlling device (fig. 1-2; col. 3, line 21 to col. 4, line 24);

- transmitting DUT data to remote controller (fig. 1-2; col. 3, line 21 to col. 4, line 24);

- controlling testing device using input from remote controller (fig. 1-2; col. 3, line 21 to col. 4, line 24);

- initializing, establishing and transmitting data/attribute of DUT (fig. 1-2; col. 3, line 21 to col. 4, line 24);

- forwarding instructions to remote controller and forwarding to testing device (fig. 1-2; col. 3, line 21 to col. 4, line 24);

11. Chandler et al. do not disclose use of “video cameras”

12. Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time of the invention to employ video cameras during remote testing of DUTs because this provides other sources of information to the user which would not be as apparent from, for example, only electrical signals. For example, during testing of semiconductor DUTs, a video signal could show smoke, indicating overheating of the DUT.

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Response to Arguments

13. Applicant's arguments filed 4/3/2003 have been fully considered but they are not persuasive.

14. The Examiner notes Applicant's arguments pertaining to the 102 prior art rejections. Applicants again recite numerous court decisions, followed by a recitation of the prior art rejection, followed by a paraphrasing of the claimed invention and the conclusory statement that the invention is in "marked contrast". Applicants are reminded that the prior art rejections were applied after a review of the claims. The Examiner, respectfully, is not persuaded by Applicant's arguments and refers Applicants to the prior art rejections. Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims *patentably distinguishes* them from the references.

15. The Examiner maintains the rejections and would also like to point out that a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings combination with his own knowledge of the particular art and be in possession of the invention. *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

16. The Examiner notes Applicant's arguments pertaining to the 103 prior art rejections. Applicants again recite court decisions, followed by a recitation of the prior art rejection, followed by a paraphrasing of the claimed invention and allegations that the proposed

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combination does not disclose the invention. Applicants are reminded that the prior art rejections were applied after a review of the claims.

17. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

18. The Examiner, respectfully, is not persuaded by Applicant's arguments and refers Applicants to the prior art rejections. Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims *patentably distinguishes* them from the references.

19. In response to Applicants' various arguments that the art did not *anticipate* or *render obvious*, the Examiner refers Applicants to the MPEP.

20. The MPEP explicitly states: "A **prima facie** case of unpatentability is established when the information compels a conclusion that a claim is **unpatentable under the preponderance of evidence**, burden-of-proof standard, giving each term in the claim its **broadest reasonable construction consistent with the specification**, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability" and "An application should not be allowed, unless and until issues pertinent to patentability have been raised and resolved in the course of examination and prosecution, since otherwise the resultant patent would not justify the statutory presumption of validity (35

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U.S.C. 282), nor would it “strictly adhere” to the requirements laid down by Congress in the 1952 Act as interpreted by the Supreme Court. The **standard** to be applied in all cases is the “**preponderance of the evidence**” test. In other words, **an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable** and “In rejecting claims for want of novelty or for obviousness, the **examiner must cite the best references at his or her command**. When a reference is *complex* or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, *if not apparent*, must be clearly explained and each rejected claim specified” Examiner does not believe this application raises to the level of “complex”.

21. Anticipation is a question of fact. *In re King*, 801 F.2d 324, 231 USPQ 136 (Fed. Cir. 1986). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984), it is only necessary for the claims to " 'read on' something disclosed in the reference, i.e., all limitations in the claim are found in the reference, or 'fully met' by it." Where, as here, a reference describes a class of compositions, the reference must be analyzed to determine whether it describes a composition(s) with sufficient specificity to constitute an anticipation under the statute. See *In*

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re Schaumann 572 F.2d 312, 197 USPQ 5 (CCPA 1978). (reciting from: *Ex parte Lee*, BPAI at 31 USPQ2d 1105)

22. The *prima facie* case is a procedural tool which, as used in patent examination (as by courts in general), means not only that the evidence of the prior art would reasonably allow the conclusion the examiner seeks, but also that *the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it*. See Black's Law Dictionary 1071 (5th Ed. 1979). See generally *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing cases showing the evolution of the concept in patent examination of *prima facie* obviousness as a legal inference drawn from uncontradicted evidence) (reciting from *In re Spada* (CAFC) 15 USPQ2d 1655 (8/10/1990)). Especially in view of the fact that the courts have held that “A reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.” *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sase*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

23. **Prima facie** means at first sight, on the first appearance, on the face of it, so far as can be judged from the first disclosure, presumably or a fact presumed to be true unless disproved by some evidence to the contrary. *Prima facie* case is made when such will prevail until contradicted and overcome by other evidence or which has proceeded upon sufficient proof to that stage where it will support finding if evidence to the contrary is disregarded. (recited

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from: Black's Law Dictionary, 5th Edition) A prima facie case can be made by the Examiners' assertion of the prior art associated with the pending claims that would render the claims unpatentable. As to the allowability or patentability of Applicants' claimed invention, only a "preponderance of the evidence" needs to be applied to make the determination of the allowability or patentability of pending claims. The Examiner notes that Applicants *have not* shifted the burden to the Examiner in response ^{to} the prima facie showing.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

25. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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26. Any inquiry concerning this communication or earlier communications from the examiner should be:

directed to:

Dr. Hugh Jones telephone number (703) 305-0023, Monday-Thursday 0830 to 0700 ET, *or* the examiner's supervisor, Kevin Teska, telephone number (703) 305-9704. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)
or (703) 308-1396 (for informal or draft communications, please label "*PROPOSED*" or "*DRAFT*").

Dr. Hugh Jones
Primary Patent Examiner

~~April 20, 2002~~

202 *May 10,*

HUGH JONES Ph.D.
PRIMARY PATENT EXAMINER
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Hugh Jones